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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,998	07/30/2001	Marco Steiger	G 3752	1503

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EXAMINER

MCDONALD, SHANTESE L

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 12/21/2001

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/917,998

Applicant(s)
Steiger et al.

Examiner
Shantese McDonald

Art Unit
3723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 30, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15, 16, 18, and 19 is/are rejected.
- 7) ☒ Claim(s) 12-14, 17, and 20 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/123,759.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear as to what is meant by “substantially normal to said direction”, in claim 1, lines 11-12 and claim 18, lines 10-11. What direction is being referred to? Further clarification is needed. It is also noted that “substantially” is spelled incorrectly in line 11.

3. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What is a “trapeziform” outline?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-3, 6, 9-11, 15,16, 18,19 are rejected under 35 U.S.C. 102(b) as being anticipated by Franklin et al.

Franklin et al. teaches a tool having a power driven output shaft, 209, comprising an elongated member, 203, having a first section to be mounted on the output shaft, a second section, 207, remote from the first section, having at least one at least substantially straight cutting edge, which comprises two adjoining sections disposed at an acute angle, (fig. 14), and having a third section disposed between the first and second sections, (Fig. 13). Franklin et al. also teaches a plurality of discrete tools, (col. 7, lines 33-36).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al.

Franklin et al. teaches all the limitations of the claims except for the material removing element comprising industrial diamonds and corundum. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to make the tool of Franklin with industrial diamonds and corundum, since it has been held to be within the general skill of a

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worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al.

Franklin et al. teaches all the limitations of the claims except for the acute angle being between 1.5 and 4.6 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the acute angle of Franklin et al. between 1.5 and 4.6 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Allowable Subject Matter

9. Claims 12-14, 17 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Swank was cited to show another example of a manual tool.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shantese McDonald whose telephone number is (703) 308-8722.



Joseph J. Hail, III
Supervisory Patent Examiner
Technology Center 3700

S.L.M.

December 14, 2001